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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,916	07/09/2001	Hiroshi Shiku	P20854	1184

7055 7590 11/10/2004
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EXAMINER

EWOLDT, GERALD R

ART UNIT PAPER NUMBER

1644

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/787,916

Applicant(s)

SHIKU ET AL.

Examiner

G. R. Ewoldt, Ph.D.

Art Unit

1644

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 15 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

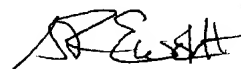
Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 13 and 14.

Claim(s) withdrawn from consideration: 1-12 and 15-20.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

11/8/04

G.R. EWOLDT, PH.D.
PRIMARY EXAMINER

DETAILED ACTION

1. As set forth previously, amended Claims 1-12 and Claims 15-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to cells capable of inducing cellular immunity, i.e., antigen presenting cells APCs (and methods of producing said cells). The invention under examination is a method for inducing cellular immunity (and previously the effector cells of cellular immunity, CTL).

Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 1-12 and 15-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Claims 13 and 14 are being acted upon.

3. Applicant has requested that the finality of the previous action be withdrawn and that the invention now recited in the claims be examined. Applicant argues that the Examiner should have known what Applicant actually intended to claim and should have acted accordingly.

Applicant's request is denied.

Applicant is advised that the specification discloses both "cells with induced cellular immunity" and "cells capable of inducing cellular immunity". Clearly, these are two different cell types. It is the Examiner's interpretation of the specification that "cells with induced cellular immunity" are cytotoxic T cells and "cells capable of inducing cellular immunity" are APCs. See, for example, the first paragraph of the specification. Said paragraph discloses both antigen presenting cells and T cells. The paragraph discloses that APCs reacted as set forth in the specification achieve "induction of cellular immunity, particularly cytotoxic T cells". Thus, it is clear that the "cells with induced cellular immunity" are T cells, i.e., the invention of the original claims.

Applicant argues that unity of invention practice should be followed if restriction is required.

Applicant is advised that lack of unity of invention has actually been established as regards the invention of the

original claims given the art rejections of the first Office action. Also note that a review of 37 CFR 1.475 (cited by Applicant), which indicates which types of patentably distinct inventions would be considered to have unity of invention, does not include multiple products. Indeed, part (d) specifically excludes inventions drawn to multiple products. Thus, "cells with induced cellular immunity" and "cells capable of inducing cellular immunity" would not have unity of invention.

Applicant has presented new arguments traversing the instant rejections.


Applicant is advised that new arguments requiring new considerations will not be entered.

4. Applicant is advised that, while not required, upon the filing of an RCE, the Examiner will allow Applicant to switch inventions as a courtesy.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841.

6. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Additionally, the Technology Center receptionist can be reached at (571) 272-1600.

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11/8/04
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